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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/041,946

Applicant(s)

WOLFSTON, JAMES H.

Examiner

OJO O. OYEBISI

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In view of the Appeal Brief filed on 09/19/08 and the recent Federal Circuit decisions (In Re Bilski) which necessitates the new ground of rejection set forth in this office action, PROSECUTION IS HEREBY REOPENED. To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Claim Rejections - 35 USC §101

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-35 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (*In Re Bilski*), §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).
4. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.
5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter recited in claims 1-35, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory. Thus, to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied and should sufficiently transform the underlying subject matter. Note that claims 11-13 are directed to a system of providing liquidity to merchants, at least in the preamble. However, there is no description of the system in the body of the claim, and the steps recited in the body of the claim are not sufficiently tied to the claimed system.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US PAT: 6,317,745) in view of Treider et al (Treider hereinafter, US PAT: 7,082,412).

Re claims 30-31, and 34. Thomas discloses a method of facilitating a transaction between a merchant and a payor (see abstract), comprising: verifying by a biller the validity of a charge of a transaction amount for a transaction between a merchant and a payor; charging the transaction amount to the payor's account (i.e., the home banking system computer is operable, upon receipt of the payment order from the payor station, to generate a universal identifier number uniquely identifying the payee and to transmit electronically the universal identifier number to the trusted third party via a communication with the trusted third party system. The trusted third party system

computer also being operable, in response to receipt of the universal identifier number from the home banking system, to identify the payee as a party to receive payment, to generate a routing/transit number of the bank of the payee and the payee's account number from the universal identifier number, and to communicate electronically with the bank of the payee to facilitate transfer of the amount owed to the payee's account to the bank of the payee, see abstract), the liquidity source being unaffiliated with the biller; collecting the transaction amount from the payor; and transferring an amount corresponding to the transaction amount to repay the liquidity source (see col.6 lines 22-55). Thomas does not explicitly disclose thereby triggering payment of an amount corresponding to the transaction amount from a liquidity source to the merchant. However, Treider discloses thereby triggering payment of an amount corresponding to the transaction amount from a liquidity source to the merchant (i.e., Treider discloses a credit card payment to the merchant, see fig.3. The examiner has interpreted the Credit card to be the liquidity source). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Thomas and Treider so that credit card companies/funds providing companies can use the trusted third party system of Thomas to present bills to the payor (i.e., bills of all the credit card funds provided to the payor for making a purchase in Treider (fig.3)), and also to compensate the third party for the services they provide.

Re claims 1-4, 32 and 35. Thomas discloses a method of financing transactions between payors and merchants (see abstract), the payors charging utility or other billing accounts serviced by third parties in order to complete the transactions with the

merchants proceeds of the transactions being initially provided to the merchants by one or more participating funds owned and managed separately from the third parties and unaffiliated with those third parties (i.e., credit card), and the transaction proceeds being later restored to the funds by the third parties (see abstract, also see col.5 lines 35-65), the method comprising; charging by a payor to a third party billing account a transaction amount charged by a merchant; collecting by the third party the transaction amount from the payor (see col.5 lines 35-65); and transferring funds corresponding to the transaction amount from the third party to the fund (see abstract, see col.5 lines 15-65). Thomas does not explicitly disclose transferring from one of the participating funds to the merchant the transaction amount minus a service fee; compensating the third party (i.e., guaranteeing financial institution) and the fund from the transaction amount, whereby the merchant has use of the major portion of the transaction amount shortly after charging by the payor, the third party receives compensation for its service, and the fund receives compensation that provides a return on investment to the fund to the benefit of its investors. However, Treider discloses transferring from one of the participating funds to the merchant the transaction amount minus a service fee; compensating the third party and the fund from the transaction amount, whereby the merchant has use of the major portion of the transaction amount shortly after charging by the payor, the third party receives compensation for its service, and the fund receives compensation that provides a return on investment to the fund to the benefit of its investors (i.e., referring to FIG. 1, the buyer makes a purchase from the vendor with a guaranteed credit line as established in the profile database 10. The purchase order is

then being forwarded to the vendor for fulfillment 12. Then the receivable is re-assigned to the guaranteeing financial institution for a guarantee of the receivables 14, the purchase order is returned to the buyer for the buyer's records 16. The vendor ships the order with a copy of the invoice and terms back to the buyer 18, for example, net 30, net 60, or net 90. Then the vendor sends shipment confirmation and a copy of the invoice to the platform for the present invention, entitled "ProfitScape" (hereinafter referred to as the platform), on an e-commerce web site 20. Next the buyer makes payment to the platform based upon the vendor terms 22, and the platform forwards payment to the vendor 24, minus a negotiated percentage. The platform profile database maintains credit records and transfers all monies from the buyer to the vendor minus a negotiated percentage or transaction fee, for example 8 12% of the transaction. The guaranteeing financial institution will review the accounts periodically, for example every 90 days, for buyer credit line limits. Also periodically, for example every 30 days, the platform reconciles with the guaranteeing financial institution for a percentage of all gross revenue of the platform's guaranteed electronic commerce transactions, see col.9 lines 35-65). Thus, it would have been obvious to one of ordinary skill in the art to combine Thomas and Treider in order to compensate the third party for the services they provide.

Re claims 6, 22. Thomas discloses a method of facilitating payment between a payor and a merchant (see abstract), comprising: undertaking by a payor of an obligation to pay a merchant a transaction amount; billing the payor by a third party biller, the third party biller being an entity other than the liquidity source; collecting the transaction

amount from the payor by the third party biller (see col.4 lines 25-65); and providing by the third party biller funds corresponding to the transaction amount to the liquidity source (see abstract), the liquidity source being repaid by payor funds collected by the third party biller (see col.6 lines 22-55). Thomas does not explicitly disclose providing funds corresponding to the transaction amount to the merchant from a liquidity source (i.e., credit card). However, Treider discloses providing funds corresponding to the transaction amount to the merchant from a liquidity source (i.e., Treider discloses a credit card payment to the merchant, see fig.3. The examiner has interpreted the Credit card to be the liquidity source). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Thomas and Treider so that credit card companies/funds providing companies can use the trusted third party system of Thomas to present bills to the payor (i.e., bills of all the credit card funds provided to the payor for making a purchase in Treider (fig.3)), and also to compensate the third party for the services they provide.

Re claim 5. Thomas further discloses a computer readable media having thereon instructions for executing computer instructions (see fig.2B).

Re claims 7-9, 25. Thomas does not explicitly disclose the method in which providing funds corresponding to the transaction amount to the merchant from a liquidity source includes providing funds equal to the transaction amount minus a service fee, a first portion of the service fee being used to compensate the liquidity source and a second portion of the service fee being used to compensate the biller. However, Treider makes this disclosure (i.e., referring to FIG. 1, the buyer makes a purchase from the vendor

with a guaranteed credit line as established in the profile database 10. The purchase order is then being forwarded to the vendor for fulfillment 12. Then the receivable is re-assigned to the guaranteeing financial institution for a guarantee of the receivables 14, the purchase order is returned to the buyer for the buyer's records 16. The vendor ships the order with a copy of the invoice and terms back to the buyer 18, for example, net 30, net 60, or net 90. Then the vendor sends shipment confirmation and a copy of the invoice to the platform for the present invention, entitled "ProfitScape" (hereinafter referred to as the platform), on an e-commerce web site 20. Next the buyer makes payment to the platform based upon the vendor terms 22, and the platform forwards payment to the vendor 24, minus a negotiated percentage. The platform profile database maintains credit records and transfers all monies from the buyer to the vendor minus a negotiated percentage or transaction fee, for example 8 12% of the transaction. The guaranteeing financial institution will review the accounts periodically, for example every 90 days, for buyer credit line limits. Also periodically, for example every 30 days, the platform reconciles with the guaranteeing financial institution for a percentage of all gross revenue of the platform's guaranteed electronic commerce transactions, see col.9 lines 35-65). Thus, it would have been obvious to one of ordinary skill in the art to combine Thomas and Treider in order to compensate the third party for the services they provide.

Re claim 10. Thomas discloses the method in which billing the payor by a third party biller includes billing the payor by a third party that offers goods or services and that maintains a billing system for collecting charges in connection with its own goods or

services (see abstract).

Re claims 11-12, 26. Thomas discloses a system of providing liquidity to merchants and facilitating payments by payors (see abstract), comprising: a third party biller different from the source of funds for billing the payor (see col.4 lines 25-60), collecting funds from the payor, and reimbursing the source of funds (see col.5 lines 35-60). Thomas does not explicitly disclose a source of funds (i.e., credit card) for paying the merchant when a transaction is undertaken. However, Treider discloses a source of funds (i.e., credit card) for paying the merchant when a transaction is undertaken (i.e., Treider discloses a credit card payment to the merchant, see fig.3. The examiner has interpreted the Credit card to be the liquidity source). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Thomas and Treider so that credit card companies/funds providing companies can use the trusted third party system of Thomas to present bills to the payor (i.e., bills of all the credit card funds provided to the payor for making a purchase in Treider (fig.3)), and also to compensate the third party for the services they provide.

Re claim 13. Thomas does not explicitly disclose the system in which the source of funds is other than a traditional bank. However, Treider discloses the system in which the source of funds is other than a traditional bank (i.e., guaranteeing financial source, see abstract). Thus it would have been obvious to combine Thomas and Treider to provide the buyer/payor a choice of different financial sources.

Re claims 14-17. Thomas discloses a method of financing transactions between merchants and payors, comprising: accepting money to be pooled in a fund; in

response to a transaction between a merchant and a payor (see abstract), a transaction amount being charged to the payor's account at a third party who is unrelated to the party accepting the money to be pooled in the fund (see abstract, also see col.5 lines 35-55); transferring the transaction amount ; and receiving funds corresponding to the transaction amount collected from the payor by the unrelated third party (see col.6 lines 23-40). Thomas does not explicitly disclose transferring the transaction amount less a service fee from the pooled fund to the merchant. However, Treider makes this disclosure (i.e., referring to FIG. 1, the buyer makes a purchase from the vendor with a guaranteed credit line as established in the profile database 10. The purchase order is then being forwarded to the vendor for fulfillment 12. Then the receivable is re-assigned to the guaranteeing financial institution for a guarantee of the receivables 14, the purchase order is returned to the buyer for the buyer's records 16. The vendor ships the order with a copy of the invoice and terms back to the buyer 18, for example, net 30, net 60, or net 90. Then the vendor sends shipment confirmation and a copy of the invoice to the platform for the present invention, entitled "ProfitScape" (hereinafter referred to as the platform), on an e-commerce web site 20. Next the buyer makes payment to the platform based upon the vendor terms 22, and the platform forwards payment to the vendor 24, minus a negotiated percentage. The platform profile database maintains credit records and transfers all monies from the buyer to the vendor minus a negotiated percentage or transaction fee, for example 8 12% of the transaction. The guaranteeing financial institution will review the accounts periodically, for example every 90 days, for buyer credit line limits. Also periodically, for example every 30 days,

the platform reconciles with the guaranteeing financial institution for a percentage of all gross revenue of the platform's guaranteed electronic commerce transactions, see col.9 lines 35-65). Thus, it would have been obvious to one of ordinary skill in the art to combine Thomas and Treider in order to compensate the third party for the services they provide.

Re claims 18, 33. Thomas discloses a method of brokering transactions between payors and merchants (see abstract), comprising: presenting to a payor, in response to a transaction between the payor and a merchant, a request to select an account at a third party biller to which to charge a transaction amount (see col.4 lines 25-65); requesting authorization of the charge from the selected third party biller; triggering the selected third party biller to bill the payor; the liquidity source being repaid by the third party biller (see col.6 lines 22-55). Thomas does not explicitly disclose requesting a liquidity source (i.e., credit card) that is not the same entity as the third party biller to transfer funds corresponding to the transaction amount to the merchant. However, Treider discloses requesting a liquidity source (i.e., credit card) that is not the same entity as the third party biller to transfer funds corresponding to the transaction amount to the merchant (i.e., Treider discloses a credit card payment to the merchant, see fig.3. The examiner has interpreted the Credit card to be the liquidity source). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Thomas and Treider so that credit card companies/funds providing companies can use the trusted third party system of Thomas to present bills to the payor (i.e., bills of all the

credit card funds provided to the payor for making a purchase in Treider (fig.3)), and also to compensate the third party for the services they provide.

Re claim 19. Thomas does not explicitly disclose the method further comprising collecting a broker fee from the liquidity source or from the third party biller. However, Treider makes this disclosure (i.e., The platform profile database maintains credit records and transfers all monies from the buyer to the vendor minus a negotiated percentage or transaction fee, for example 8 12% of the transaction. The guaranteeing financial institution will review the accounts periodically, for example every 90 days, for buyer credit line limits. Also periodically, for example every 30 days, the platform reconciles with the guaranteeing financial institution for a percentage of all gross revenue of the platform's guaranteed electronic commerce transactions, see col.9 lines 35-65). Thus, it would have been obvious to one of ordinary skill in the art to combine Thomas and Treider in order to compensate the third party for the services they provide.

Re claims 20, 24. Thomas does not explicitly disclose the method in which requesting a liquidity source to transfer funds includes selecting one of multiple liquidity sources. However, Treider makes this disclosure (i.e., form of payment (credit card and ProfitScape, see fig.3). Thus it would have been obvious to combine Thomas and Treider to provider the users with different payment options or a choice of different funding sources.

Re claims 21, 23. Thomas does not explicitly disclose the method in which requesting a liquidity source to transfer funds corresponding to the transaction fee to the merchant includes requesting the liquidity source to transfer funds equal to the transaction amount

minus a service fee, a portion of the service fee being retained by the liquidity fund. However, Treider makes this disclosure (i.e., Next the buyer makes payment to the platform based upon the vendor terms 22, and the platform forwards payment to the vendor 24, minus a negotiated percentage. The platform profile database maintains credit records and transfers all monies from the buyer to the vendor minus a negotiated percentage or transaction fee, for example 8 12% of the transaction. The guaranteeing financial institution will review the accounts periodically, for example every 90 days, for buyer credit line limits. Also periodically, for example every 30 days, the platform reconciles with the guaranteeing financial institution for a percentage of all gross revenue of the platform's guaranteed electronic commerce transactions, see col.9 lines 35-65). Thus, it would have been obvious to one of ordinary skill in the art to combine Thomas and Treider in order to compensate the third party for the services they provide.

Re claim 27. Thomas discloses the method in which participating as a merchant in a transaction in which a payor agrees to pay the merchant a transaction amount to be charged to a billing account at a third party includes participating as a merchant in a transaction in which a payor agrees to pay the merchant a transaction amount to be charged to a billing account at a third party that offers goods or services and in which a subject matter of the transaction is not the goods or services offered by the third party (see col.5 lines 15-55, also see the abstract).

Re claims 28-29. Thomas discloses the method in which participating as a merchant in a transaction in which a payor agrees to pay the merchant a transaction amount to be charged to a billing account at a third party includes participating as a merchant in a

transaction in which a payor agrees to pay the merchant a transaction amount to be charged to a billing account (see col.4 lines 25-60, also see abstract, note the location of the billing account i.e., utility company, a department store, or an oil or gasoline company is a descriptive non-functional element which does not carry any patentable weight).

Response to Arguments

Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/
Examiner, Art Unit 3696

Application Number**Application/Control No.**

10/041,946

**Applicant(s)/Patent under
Reexamination**

WOLFSTON, JAMES H.

Examiner

OJO O. OYEBISI

Art Unit

3696